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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER J. KAEHLER, JOHN L. ERICKSON,
LEONARD R. STEIDEL, and PETER L. HAUSER

Appeal 2009-007097
Application 10/687,223
Technology Center 3600

Before: MURRIEL E. CRAWFORD, HUBERT C. LORIN, and BIBHU R. MOHANTY, *Administrative Patent Judges*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal from the final rejection of claims 1-12 and 19-25[1]. We have jurisdiction to review the case under 35 U.S.C. §§ 134 and 6 (2002).

The claimed invention is directed to methods, devices, and systems for benefits management. One system includes a server including an application interface and access to a data store having one or more client files. A client file can include a definable set of business rules for managing and administering benefits and can include fund use rules for accessing and applying funds to claims from one or more accounts. The system includes a program operable on the server to apply the definable set of business rules in connection with processing a claim. (Spec., Abstr.). Claim 1, reproduced below, is further illustrative of the claimed subject matter.

> 1. A system for benefits management, comprising:
>
> a server including an application interface and access to a data store having one or more client files, wherein a client file includes a definable set of business rule instructions executed by a processor to manage and administer benefits and includes fund use rule instructions executed by a processor to access and apply funds to payment of claims from a plurality of accounts; and
>
> a program operable on the server to apply the definable set of business rules, wherein the instructions are executed by the processor to allow a plan sponsor to define a first defined set of the fund use rules and a plan member to define a second defined set of the fund use rules in order to define payment of at least a portion of a claim from between at least two different employee benefit accounts, dependent upon authority being granted by the plan sponsor.

[1] Claims 26-30 and 32 were cancelled on page 6 of the Reply Brief. The Reply Brief was entered and considered by the Examiner on March 3, 2009.

Claims 1-12 and 19-25 stand rejected under 35 U.S.C. § 101 for failing to recite patentable subject matter; claims 1-12 and 19-25 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Lencki (US Pub. 2002/0049617 A1, pub. Apr. 25, 2002) in view of Deavers (US Pat. 6,044,352, iss. Mar. 28, 2000).

We AFFIRM.

ISSUES

Did the Examiner err in asserting that claims 1-12 and 19-25 are not directed to statutory subject matter as set forth in 35 U.S.C. § 101?

Did the Examiner err in asserting that a combination of Lencki and Deavers renders obvious the subject matter of claims 1-12 and 19-25?

FINDINGS OF FACT

Lencki

Lencki discloses methods of processing benefit claims and providing customer service. A method of processing a benefit claim consistent with the invention includes: receiving a signal comprising data representing individual line items within a benefit category purchased by the individual; automatically building a benefit profile for the individual based on the data; and authorizing payment of the claim based on the benefit profile (para. [0011]).

Deavers

Deavers discloses permitting individuals, families, and defined groups, such as employers on behalf of their employees, or affiliation groups on behalf of their members, to establish medical savings accounts in an efficient and economical fashion. A medical savings account can be defined as a plan under which a sum of money can be set aside and which in part is used to pay for a health insurance policy with a high deductible and the remainder to pay medical expenses (up to the deductible amount), if any, and to retain the balance, if any, for future use or savings (col. 1, ll. 11-29).

In the event monies are received in excess of the limitations described above, the monies might be split to permit the maximum permissible to be included in the MSFA with excess placed into a separate account (col. 4, ll. 59-62).

ANALYSIS

35 U.S.C. § 101

We are persuaded that the Examiner erred in asserting that claims 1-12 and 19-25 are not directed to statutory subject matter as set forth in 35 U.S.C. § 101 (Reply Br. 5-7). Independent claim 1 recites a system, a server, an application interface, a data store, and a processor. Independent claim 19 recites a computer readable medium and a processor. In other words, both claims recite machines or articles of manufacture, and thus the Examiner has not shown why the machine-or-transformation test, normally applied only to process or method claims, is applicable to these claims.

Lencki and Deavers

We are not persuaded that the Examiner erred in asserting that a combination of Lencki and Deavers renders obvious the subject matter of claims 1-12 and 19-25 (App. Br. 24-32; Reply Br. 7-16). Appellants assert that Deavers does not disclose plan sponsor and plan member rules for defining payment of claims from employee benefit accounts (App. Br. 29; Reply Br. 12). However, Lencki is cited for authorizing payment of claims based on benefit rules (para. [0011]) (Exam'r's Ans. 5, 10). *See In re Keller*, 642 F.2d 413, 426 (CCPA 1981) (one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references). Deavers is cited for disclosing the plurality of accounts (Exam'r's Ans. 5-6, 11, 15-16).

Appellants assert that Deavers "teaches away from using plan sponsor and plan member rules 'in order to define payment of at least a portion of a claim from between at least two different employee benefit accounts'" (emphasis original), because Deavers discloses setting aside funds for "'payment of future medical expenses'" or "'to pay for a health insurance policy with a high deductible and the remainder to pay medical expenses'" and "'to retain the balance, if any, for future use or savings'" in an interest bearing account (App. Br. 29-32; Reply Br. 12-16). However, a teaching away requires discouragement. *See In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). While Deavers may be primarily directed to managing multiple accounts for payment of future medical expenses, there is no discouragement of making claims payments from these multiple accounts, as asserted by the Examiner when combined with Lencki.

DECISION

The rejection of claims 1-12 and 19-25 under 35 U.S.C. § 101 is REVERSED.

The rejection of claims 1-12 and 19-25 under 35 U.S.C. § 103(a) is AFFIRMED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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